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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HAND, MELANIE JO

ART UNIT PAPER NUMBER

3761

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/612,154

Applicant(s)

ELFSTROM ET AL.

Examiner

Melanie J. Hand

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed September 8, 2006, with respect to the rejection(s) of claim(s) 1-33 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a newly found prior art reference.

### ***Claim Objections***

Claim 18 is objected to because of the following informalities: the word "preferably" and the phrase that it is associated with together constitute exemplary claim language. Appropriate correction is required.

Claim 24 is objected to because of the following informalities: the phrase "such as" constitutes exemplary claim language. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how a liquid-permeable barrier can also be hydrophobic.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 6-14, 16-20, 23-28, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rooyackers (U.S. Patent No. 4,675,012) in view of Li (U.S. Patent No. 4,023,216).

With respect to **claims 1,26,34**: Rooyackers teaches an absorbent product for men, comprising a front section indicated generally at 180, a rear section indicated generally at 176, and a crotch section 118 between the front and rear sections, an absorption body 194 which tapers towards one end from a front section of the product towards the crotch section of the product and which is enclosed in a sheath comprising a liquid-tight layer 196 on a side of the absorption body facing away from the user during use and a liquid-permeable layer 192 on an opposite side of the absorption body, both of which layers extend beyond the absorption body and are mutually joined together, and the absorption body 194 is arranged to extend, during product usage, from the front section of the product in the direction of the crotch section 118 and is adapted to extend with its narrower end section to slightly below the penis of the user as seen in Fig. 7.

Rooyackers does not teach a liquid barrier applied on the liquid-permeable layer 192 at the narrower end section of the absorption body. Li teaches a portable urinal that contains a liquid-permeable absorbent material 18 disposed on the innermost surface of said urinal. Li teaches that the permeable material is arranged to prevent urine emitted by the user from leaking from the surface of the absorption body (Col. 3, lines 35-40), therefore it would be obvious to one of ordinary skill in the art to place a liquid permeable barrier adjacent the innermost layer of the device of Rooyackers to prevent urine leakage as taught by Li.

With respect to **claims 2,27**: The absorbent product 40 taught by Rooyakkers is an insert adapted for use with underpants 44 and the absorbent product is provided with one or more fastening members in the form of adhesive strips on an outer side of the liquid-tight layer, which fastening members are adapted to hold the absorbent product 40 in place inside the underpants 44. (Col. 6, lines 54-61)

With respect to **claim 3**: The product taught by Rooyakkers as a whole has a pants shape, the front section and the rear section being adapted to surround a waist of the user. Rooyakkes teaches a typical male brief for underpants 44, wherein a typical male brief has a front or rear section is provided with waist elastic which is adapted to hold the absorbent product in place on the user.

With respect to **claim 6**: The liquid barrier taught by Li is arranged to follow the contour of the lower, narrower end section of the absorption body and is applied in its entirety inside the said contour.

With respect to **claim 7**: The combined teaching of Rooyakkers and Li teaches a liquid barrier that crosses the absorption body close to its narrower end and the liquid barrier is convex in the direction of the said end, as it follows the contour of the absorption body at said narrower end, which is convex.

With respect to **claim 8**: The liquid barrier of the combined teaching of Rooyakkers and Li

Art Unit: 3761

extends in the lateral direction beyond the absorption body and in the transverse direction spans the whole of the absorbent product taught by Rooyakkers.

With respect to **claims 9-11**: Rooyakkers teaches a volume for device 40 of 275-400 cm<sup>3</sup> and an equilateral triangle-shaped opening that is 10 cm on each side, therefore the depth of said pouch is between 12-18 inches. (Col. 6, lines 26-33) Rooyakkers teaches a desirable cross-sectional area for a point 5-6.5 cm down the back wall to ensure that the slope is not too severe as to limit proper placement of the penis of the user (Col. 6, lines 46,47), therefore Examiner is considering the portion that is between 6.5 cm down the back wall and the bottom as the effective absorbent end portion that is substantially identical to the claimed invention and thus the height of the effective absorbent end portion has a height in the range of 65 - 180 mm, thus satisfying the relevant limitations of claims 9-11.

With respect to **claim 12**: The liquid barrier taught by Li is a separate deformable pad and is thus capable of being fixed in the rest of the absorbent product only along its outer edge section and inner-situated sections. Such outer edge section and inner-situated sections of the liquid barrier are capable of being arranged to be raised from the liquid-permeable layer during product usage simply by folding the absorbent barrier taught by Li and placing said barrier in the crotch portion of the device of Rooyakkers.

With respect to **claim 13**: The liquid barrier taught by Li is constituted by a roll formed from one or more band-shaped materials, which roll is capable of being bent into a convex shape in the direction of the narrower end of the absorption body.

With respect to **claim 14**: Li does not teach that the absorbent liquid barrier is constituted by a number of circumferential folds, however the material of the barrier is foldable, and in order for the barrier to carry out its proper function of collecting excess urine from a user's penis, it would be obvious to one of ordinary skill in the art to perform a number of circumferential folds of the one or more band-shaped materials defining the barrier taught by Li with a reasonable expectation of success, which liquid barrier, following the formation of the folds, is elongated in the direction of the fold lines forming the folds, and the liquid barrier is folded or bent into shape.

With respect to **claim 15**: Rooyakkers teaches, as can best be seen from Fig. 12, that the resulting said narrow end portion has a "V" shape. Rooyakkers does not teach a barrier. Li teaches a barrier but does not teach folding the barrier in the manner set forth in claim 15, however it has been established herein that the barrier is capable of being folded in such a manner as to fit in the crotch section of the device of Rooyakkers and that it would be obvious to one of ordinary skill in the art to do so.

With respect to **claim 16**: As can best be seen in Fig. 15, Rooyakkers teaches a "U-shaped" narrow end, where the base of the "U" resides in the crotch section when worn with an undergarment. Rooyakkers does not teach a barrier. Li teaches a barrier but does not teach folding the barrier in the manner set forth in claim 15, however it has been established herein that the barrier is capable of being folded in such a manner as to fit in the crotch section of the device of Rooyakkers and that it would be obvious to one of ordinary skill in the art to do so.

With respect to **claim 17**: Rooyakers does not teach a particular folding angle for the U-shaped narrow end. As seen in Figs. 9 and 13-15, the angle is clearly less than 90 degrees. Applicant

does not set forth a criticality for the measurement of the angle that encompasses the alternate teaching of a "V-shaped" barrier, therefore Examiner is considering the limitation that the angle be exactly 45 degrees or less than 45 degrees to be optimizations of the angle measurement and are therefore unpatentable over the prior art of the combined teaching of Rooyakkers and Li. It has been held that where general conditions of claim are disclosed in prior art, it is not inventive to discover optimum or workable ranges by routine experimentation. See *In re Aller*, Lacey and Hall (105 USPQ 233, CCPA, 1955). It would be obvious to one of ordinary skill in the art to vary the folding angle to be equal to or less than 45 degrees so as to achieve different varieties of a U-shaped barrier, as any U-shaped barrier would ensure proper support and function of the device of Rooyakkers.

With respect to **claim 18**: Li teaches that the band-shaped material for the liquid barrier consists of non-woven material. ('216, Col. 3, lines 35-40)

With respect to **claim 19**: The liquid barrier taught by Li is constituted by a single material strip 18 that has been folded or bent into suitable shape before being applied. ('216, Col. 3, lines 13-15)

With respect to **claim 20**: The single material strip 18 taught by Li is a non-woven material, but Li teaches cotton for the strip material, which is not hydrophobic. However, in light of the rejection of claim 20 under 35 U.S.C. 112, claim 20 is considered herein to be unpatentable over the combined teaching of Rooyakkers and Li.

With respect to **claims 21,22**: Li does not teach that the barrier is provided with a pretensioned



elastic element, specifically a thread, to hold said barrier in a raised state. Rather, Li teaches that the barrier is molded by steam and pressure into the desired shape, which includes a raised shape. The steam and pressure molding is considered herein to be an alternate means to providing pretensioned elastic threads for retaining said barrier in the raised state, and thus it would be obvious to one of ordinary skill in the art to use pretensioned elastic elements to retain the barrier of Li in the raised shape, rather than molding, with a reasonable expectation of success.

With respect to **claim 23**: The liquid barrier of Li is molded into its desired shape and thus has an inherent stiffness of such magnitude that the liquid barrier applied in the folded or bent state, by virtue of its own inherent stiffness in the bent or folded state during product usage, is held with its free longitudinal edge section in the raised state.

With respect to **Claim 24**: Rooyakkers teaches that the absorption body 192 is comprised of cellulose fluff pulp fibers with highly absorbent superabsorbent gel material mixed in. (Col. 6, lines 1-3) The liquid barrier taught by Li is constituted by a molding formed from airlaid cotton linter fibers. It has been established herein that the barrier taught by Li is capable of being folded in such a manner as to follow the contour of the narrower end section of the absorption body taught by Rooyakkers, on or directly outside of same, and that it would be obvious to one of ordinary skill in the art to do so.

With respect to **claim 25**: Li teaches that the liquid barrier is cast into the desired shape but does not teach a foam material. Since foam material is also a hydrophilic absorbent material capable of being cast into its desired shape, it would be obvious to one of ordinary skill in the art

to substitute foam for the cotton material taught by Li since both provide a more desired softer feel on the skin of a user.

With respect to **claim 35**: Li teaches a liquid barrier that is a separate piece that can be inserted between the liquid-tight layer and the liquid-permeable layer taught by Rooyakkers. It would be obvious to one of ordinary skill in the art to place the absorbent barrier taught by Li between the liquid-tight layer and the liquid-permeable layer as placing the barrier material in that position provides additional leakage protection.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rooyakers (U.S. Patent No. 4,675,012) in view of Li (U.S. Patent No. 4,023,216) as applied to claims 1, 2, 6-14, 16-20, 23-28, 34 and 35 above, and further in view of Wilson et al (U.S. Patent No. 6,023,789).

With respect to **claim 4**: Rooyakkers does not explicitly teach the placement of an elastic member in underpants 44. Wilson teaches sports short 10 made of Lycra® ('789, Col. 4, lines 19-21) material having a genital protector comprising at least one elastic waistband in a front section. Wilson teaches that said elastic waistbands allow accommodation of a variety of waist sizes ('789, Col. 3, lines 8-10), therefore it would be obvious to one of ordinary skill in the art to modify the briefs taught by Rooyakkers to contain at least one elastic waistband in a front section as taught by Wilson. With respect to claim 4, Wilson also teaches that the body portion of the shorts, including the crotch portion, is formed from elastic material ('789, Col. 4, lines 19-21) that is capable of being pulled down and subsequently returned to an initial position against the wearer via said elastic waistband and elastic material. Wilson teaches that the elastic

Art Unit: 3761

material applies a compressive force for added protection and moisture wicking ('789, Col. 3, lines 1-5), therefore it would be obvious to one of ordinary skill in the art to modify the underpants taught by Rooyakkers to be comprised of elastic material that is not only tight fitting (as taught by Rooyakkers) but able to be pulled and deformed for easy removal as taught by Wilson.

With respect to **claim 5**: Wilson teaches that the waist elastic 12 is formed from an elastic first piece, collectively 14,16, which, in the extended state, is essentially rectangular and which is adapted to partially surround the trunk of the user and form the rear section and side sections of the pants product, a second piece 26, incorporated in the product, is configured to form the front section and crotch section of the pants product, the second piece is elongated with two opposing end edges and two opposing longitudinal edges, the width of the second piece, at least at the crotch section, is less than the length of the first piece, the second piece with its longitudinal direction is arranged perpendicularly to the longitudinal direction of the first piece and is connected by a first end section to the one longitudinal edge section of the first piece and centrally on this, the one end section of the first piece is connected to a first side edge section of the second piece, and the second end section of the first piece (14,16) is correspondingly connected to a second side edge section of the second piece 26, and the absorption body applied, in its entirety, on the second piece.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Monday-Thursday 8:00-5:30, alt. Fridays 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie J Hand  
Examiner  
Art Unit 3761

MJH

TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Tatyana', written over the printed name and title.